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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,561	01/17/2001	Kareem I. Batarsch	3731-002	5927

7590 02/09/2004

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EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/761,561

Applicant(s)

BATARSEH ET AL.

Examiner

Frank I Choi

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 02 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-4, 716, 18-30.

Claim(s) withdrawn from consideration: _____

8. ☒ The proposed drawing correction filed on 30 January 2004 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


S. MARK CLARDY
PATENT EXAMINER
GROUP 1200-1616

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection of claims 1-4,8,11,16,18,21 over Poddymov et al. or Sanchez et al..

Continuation of 5. does NOT place the application in condition for allowance because: Claims 1-4,7-16,18-30 were rejected under 35 USC 112, second paragraph, for failing to set forth the subject matter which Applicant's regard as the invention. Applicant has made no showing that it is an inherent property of the composition and method that the complex is solid in an aqueous solution. Further, a solution cannot have a solid as a solution requires that the solid be dissolved in the solution. A mixture of a solid and a liquid in which the solid does not dissolve in the liquid is a dispersion. In any case, the claim should set forth what Applicant considers to be the invention. If the complex remains solid in an aqueous liquid than the claims should indicate the same. With respect the prior art rejections (Claim 13), Examiner again reiterates that the rejection is based on 102/103 inherency which involves a different standard than obviousness under 103. Applicant argues that a person skilled in the art would not go below a pH of 3. This misses the point, Poddymov et al. expressly discloses that complexes are formed at a pH below 3. The prior art does not disclose that no complexation occurs at a pH below 3. The prior discloses that that complexes do form at a pH of below 3, although it is significantly diminished. Since Applicant has not shown that "about 2" excludes a pH of below 3, the prior art meets the claim. Examiner notes that Applicant argues that precipitation complexation occurs at a pH of 2 or less. The claims do not state a pH of 2 or less, the claims state a pH of about 2 or less which is different in scope and, thus, raises a 112, 2nd paragraph rejection issue for failing to set forth the subject matter which Applicant regards as the invention. Applicant argues that the protons of Sanchez et al. are liberated when a metal replaces hydrogen ions in the ligand, that if very stable complexes are formed that pH measurements cannot yield accurate values of stability constants and that the complexes are different from the claimed invention because the proton in Sanchez is replaced by a metal. Applicant offers no support for these assertions. The arguments of counsel do not constitute evidence. In re Schulze, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 43 USPQ2d 1362 (Fed Cir. 1997). Applicant makes various arguments relative to the intended use, however, the claim rejected is a a method of preparation claim not a method of use claim. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963)..